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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,717	11/30/2000	Dale W. Malik	BS00-168	1249
38823	7590	09/29/2005	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ BELLSOUTH I.P. CORP 100 GALLERIA PARKWAY SUITE 1750 ATLANTA, GA 30339			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,717

Applicant(s)

MALIK, DALE W.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2142

1. Claims 1,2,4-21,23-28 are pending.

Response to Amendment

2. Applicant's arguments filed 9/09/05 with respect to claims 1,2,4-21,23-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (i.e.: the checker generates a prompt for verification of the email address upon detecting that an e-mail address in an outgoing e-mail communication is **not** present in the memory)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2,4-21,23-28 are rejected under 35 U.S.C. 103(a) as obvious over Hiroki et al [Hiroki 6,594,032 B1] in view of Cortright et al [6,895,426 B1].
5. As per claim 1, Hiroki discloses a method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

creating an incoming domain name list in a memory [Hiroki, domain name registered are stored in RAM as a domain list, Fig 14, col 9 lines 1-8];

receiving an incoming email communication [Hiroki, the email send/receive functionality available, col 7 lines 9-17];

extracting a domain name from a sender's email address from the incoming email communications [Hiroki, domain name button, 8 lines 35-50];

storing the domain name in the incoming domain name list in the a memory [Hiroki, storing domain name in storage, col 12 lines 45-50];

otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication [Hiroki, upload information to verify, col 5 lines 20-35; prompting, col 9 lines 28].

However Duval does not explicitly detail

checking if a domain name of the e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming domain name list in the memory; and transmitting the outgoing email communication if the domain name is included in the incoming domain name list,

In the same endeavor, Cortright discloses a system and process for treating Email address of incoming and outgoing messages to the intended recipients wherein the email system identifies an email address and valid domain name of the input message and check or prompt to user if it matches to a person or address [Cortright, col 7 lines 10-42, Fig 2-3; col 7 lines 42-col 8 line 43, Fig 4A-B; col 10 lines 20-26].

An Official Notice is taken that the email address includes a recipient's user name and domain name [see Chen col 1 lines 12-25].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the domain name verification process taught by Cortright into the Hiroki's apparatus in order to utilize the email system. Doing so would provide a security feature to control the incoming and outgoing email over Internet.

6. As per claim 2, Hiroki-Cortright disclose extracting a domain name from each e-mail address provided in the outgoing e-mail communication, wherein the e-mail communication is transmitted after checking each extracted domain name in the list of domain names, and confirming each e-mail address for which the extracted domain name is not included in the incoming domain name list [Cortright, the recipient list, col 8 lines 47-col 9 line 9].

7. As per claim 4, Hiroki-Cortright disclose receiving a corrected e-mail address from the user in response to the prompt; and repeating the steps of checking a corrected domain name and generating a prompt if the corrected domain name is not included in the incoming domain name list, until the user either confirms that the domain name provided in the e-mail address is correct or provides a domain name that is in the list of domain names [Cortright, prompt to choose, col 10 lines 20-26].

8. As per claim 5, Hiroki-Cortright disclose the outgoing e-mail communication is intercepted in an e-mail server to check the domain name in the e-mail address prior to transmission [Cortright, valid domain name, col 8 lines 1-12].

9. As per claim 6, Hiroki-Cortright disclose the prompt is an e-mail message from the e-mail server to the user [Cortright, prompt to choose, col 10 lines 20-26].

10. As per claim 7, Hiroki-Cortright disclose the prompt is a network message to the user [Cortright, prompt to choose, col 10 lines 20-26].

11. As per claims 21,23-25 contain the similar limitations as set forth in claims 1-2,4-7. Therefore claims 21,23-25 are rejected by the same rationale set forth claims 1-2,4-7.

12. As per claim 8, Hiroki discloses A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

receiving email communications incoming to the email communications server;
creating a domain name database [Cortright, prompt to the user to create a new contact address in the address book, col 10 ines 55-67];

extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server; storing extracted domain names in the domain name database [Cortright, valid domain, col 8 lines 1-12];

Art Unit: 2142

receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network [Cortright, LAN/WAN, col 6 lines 29-41];

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication routed in the outgoing e-mail communications [Cortright, check its contact database, col 9 lines 10-52];

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled [Cortright, data entry error, col 2 lines 1-15].

13. As per claim 9, Hiroki-Cortright disclose searching for similarly spelled domain names is performed by checking each alphanumeric character comprised in the extracted domain name with the alpha-numeric characters comprised in the domain names in the database, and detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name [Cortright, the system used an algorithm based on rules for valid domain name constructions, col 8 lines 1-12].

14. As per claim 10, Hiroki-Cortright disclose searching for similarly spelled domain names is performed by removing an alpha-numeric character from the extracted domain name and searching the domain name database for a domain name consisting of at

Art Unit: 2142

least each of the remaining alphanumeric characters in the extracted domain name [Cortright, a later search, automatically checking before sending, col 8 lines 14-43; edit, add, move, delete, modify email addresses, col 10 lines 6-44].

15. As per claim 11, Hiroki-Cortright disclose searching for similarly spelled domain names is performed by comparing the extracted domain name with reference domain names stored in the domain name database according to predetermined spelling grammar algorithms [Cortright, the system used an algorithm based on rules for valid domain name constructions, col 8 lines 1-12].

16. As per claims 12,13 Hiroki-Cortright disclose the error prompt is an e-mail message from the e-mail server to the client computer transmitting the e-mail communication [Cortright, prompt to choose, col 10 lines 20-26].

17. As per claim 14, Hiroki-Cortright disclose determining whether extracted domain names are already stored in the domain name database, whereby only a single copy of an extracted domain name is stored in the domain name database[Cortright, if the sender is already in the address book, col 11 lines 1-3].

18. As per claim 15, Hiroki-Cortright disclose storing tally information in the domain name database to tally the frequency in which domain names in the domain name

Art Unit: 2142

database are extracted from incoming e-mail communications as inherent feature of domain list or contact database.

19. As per claim 16, Hiroki-Cortright disclose deleting domain names from the domain name database that are not frequently extracted from incoming e-mail communications according to respective tally information as inherent feature of domain list or contact database.

20. As per claim 17, Hiroki-Cortright disclose the tally information for each domain name in the domain name database includes the calendar date in which the domain name was most recently extracted as inherent feature of domain list or contact database.

21. As per claims 18-20 contain the similar limitations as set forth in claims 8-17. Therefore claims 18-25 are rejected by the same rationale set forth claims 8-17.

22. As per claim 26, Hiroki discloses an e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

an address extractor for extracting senders' e-mail addresses from incoming e-mail communications [Hiroki, domain name button, 8 lines 35-50];

a memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications [Hiroki, storing domain name in storage, col 12 lines 45-50]; and

a checker for searching the memory for e-mail addresses associated with intended recipients of the that are provided in outgoing e-mail communications, wherein the checker generates a prompt for verification of the email address upon detecting that an e-mail address in an outgoing e-mail communication is not present in the memory [Cortright, contact database, address book, col 7 lines 44-67; if no match can be found, col 8 lines 14-44].

23. As per claim 27, Hiroki discloses the memory is included in an e-mail address directory [Cortright, contact database, address book, col 7 lines 44-67].

24. As per claim 28, Hiroki discloses the e-mail address directory additionally stores user-specified e-mail addresses [Cortright, contact database, address book, col 7 lines 44-67].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 09/725,717

Page 10

Art Unit: 2142

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.